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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,460	02/28/2002	Steven W. Trovinger	10014012	4991

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EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/084,460	TROVINGER, STEVEN W.
Examiner	Art Unit	
Mark T Henderson	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 September 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-34 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 4 and 5 is/are allowed.
- 6) Claim(s) 1-3,6-21,23 and 31 is/are rejected.
- 7) Claim(s) 22,24-30,32 and 34 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Request for Continued Examination

1. The request filed on November 8, 2004 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/084,460 is acceptable and an RCE has been established. An action on the RCE follows.

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2. Claims 1, 4, 5, 14, 31 and 33 have been amended for further examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 14, 15, and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13 and 16 of U.S. Patent No. 6,550,756 (Trovinger) in view of Hansch et al (EP-569,887A1).

Trovinger ('756) discloses a method of making booklets comprising: clamping a folded sheet with a reciprocating transferring device (reciprocating clamping drive); delivering the folded sheet material to a pivotable collecting device along an arc (non-linear path) established by the transferring device; pivoting the collecting device such that different portions of the folded sheet are received by the supporting sides of the collecting device.

However, Trovinger does not disclose: wherein the pivotable collecting device is reciprocating; and a collecting device having a supporting edge for the folded sheet material; clamping the folded sheet material on the collecting device with the reciprocating transferring device.

Hansch et al discloses in Fig. 1-4, 19-24, method of making a booklet comprising: a reciprocating (Webster's Dictionary defines as "to make a return for something", however, it does not mean that it has to travel the same or opposite path) pivotable collecting device comprising a supporting edge (14); and wherein the reciprocating transferring device (170) is used for clamping the folded sheet material against both of the supporting sides (seen in Fig. 22 and 23).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Trovinger's method of making booklets with a reciprocating

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pivotal collecting device, and a reciprocating transferring device which clamps on both sides of the supporting edge as taught by Hansch et al for the purpose of aligning the fold line for stapling.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 6, 14, 15, 18-20, are rejected under 35 U.S.C. 102(b) as being anticipated by Weber (4,735,406).

Weber discloses in Fig. 1, 3 and 4, a booklet maker and a method of making booklets comprising: a pivotal collecting device (3); a reciprocating transferring device (28) including a displaceable clamping component (32) which clamps the folded sheet (Col. 7, lines 50-53), wherein the reciprocating transferring device reciprocates along a non-linear path (arc path due to cam rotating) to deliver and secure a folded sheet to the collecting device; wherein the collecting device pivots (around hub (2)) to receive the folded sheet material such that portions are supported by different opposite sides of the collecting device (3); wherein the collecting device

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(3) converges at a supporting edge (seen in Fig. 3); transferring additional folded sheets to the collecting device wherein an inner fold edge of each sheet is received by an outer fold edge of a previously received sheet (Col 8, lines 4-24); stapling the stack of folded sheet material (Col. 8, line 24).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 7-21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allan et al (6,099,225) in view of Weber.

Allan et al discloses in Fig. 1, 2 and 4, a booklet maker and a method of making booklets comprising a collecting device (460) including two supporting sides, a transferring device (400), a folding device (430) for establishing a fold (240A) in a trimmed sheet material (wherein Fig. 2 discloses that the sheet is trimmed (220) by cutting (450) before it is folded); a collecting device

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(460); an input feed device (210) connected to an output tray (not shown) of a printing device (110); and a processing unit (Col. 4, lines 20-67).

However, Allan et al does not disclose a pivotable collecting device and a reciprocating transferring device.

Weber discloses in Fig. 1, 3 and 4, a booklet maker and a method of making booklets comprising: a reciprocating (returns back to input conveyor (20)) pivotable collecting device (3); a reciprocating transferring device (28) including a displaceable clamping component (32) which clamps the folded sheet (Col. 7, lines 50-53), wherein the transferring device reciprocates along a non-linear path (arc path due to cam rotating) to deliver and secure a folded sheet to the collecting device; wherein the collecting device pivots (around hub (2)) to receive the folded sheet material such that portions are supported by different opposite sides of the collecting device (3); wherein the collecting device (3) converges at a supporting edge (seen in Fig. 3); transferring additional folded sheets to the collecting device wherein an inner fold edge of each sheet is received by an outer fold edge of a previously received sheet (Col 8, lines 4-24); stapling the stack of folded sheet material (Col. 8, line 24) which forms a hole.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Allan et al's booklet maker and method of making booklets with a reciprocating transferring device and a pivotable collecting device as taught by Weber for the purpose of providing an alternative means in which to convey a sheet material form the folding device to a collecting device.

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In regards to Claim 21, the method in which transferring device delivering and pivoting does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would be obvious to deliver and pivot the sheet in any desired manner.

Allowable Subject Matter

6. Claims 4 and 5 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses a system for making booklets comprising a folding device; a saddle shaped pivotable collecting device; a rotatable transferring device; and a collecting drive for clamping a portion of the folded sheet material against the collecting device and for advancing the portion along a side of the collecting device; and including all of the other limitations of the independent claim.

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8. Claims 22, 24-30, 32 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments filed on September 24, 2004 have been fully considered but they are not persuasive.

In regards to applicant's argument that the Weber reference does not disclose a reciprocating collecting device, the examiner submit that Weber does indeed disclose a reciprocating collecting device. As stated above, Webster's dictionary defines the term "reciprocating" as "*to make a return for something*", however it does not mean that it has to travel the same or opposite path. The Weber's collecting drive is reciprocating since it rotates (pivots) and returns to the point of sheet entry (20). Applicant must further disclose the reciprocating process in further detail.

Therefore, the rejection has been maintained.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571)272-4477. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (571) 272-4483. The fax number for TC 3700 is (703)-872-9306.



MTH

December 8, 2004



A. L. WELLINGTON
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